

Remarks

This amendment is being filed with a Request for Continued Examination. Applicants request non-entry of the amendment filed on January 2, 2004 as paper no. 15 and entry of the amendment contained herein in its stead.

Claims 17-30 currently are pending in this application. Claims 17-28 and 30 stand rejected and claim 29 is objected to. Applicants note that the art rejections of record have been withdrawn.

The Office objects to the specification as lacking appropriate subtitle headings according to standard U.S. practice.

Applicants are submitting herein a substitute specification to add subtitle headings, standard formatting and an appropriate priority statement. The figure descriptions (paragraph 6 of the substitute specification) are taken directly from material in the specification as filed (now in paragraph 19). No new matter is added. Applicants request the substitute specification be entered and submit that the objections have been overcome. Page and line numbers referred to below, however, refer to the original specification, for clarity, since these references have been used previously by the Office.

Claims 17-27 are rejected under 35 U.S.C. §112, first paragraph, as allegedly not enabled. Applicants herein amend claims 17, 26 and 27 to make them more consistent with the disclosures pointed to by the examiner (page 8, lines 23-30). The claims now recite that purified nucleic acids and/or oligonucleotides are isolated from the silicon dioxide bound fraction. Applicants submit that this amendment overcomes the rejection under section 112 and request its withdrawal. Applicants would like to note, however, that the supernatant, or

soluble fraction was not discarded during the isolation procedure as stated in the Office Action (page 3), but was "carefully decanted" (page 8, lines 29-30) and then stored at -20°C (page 8, lines 37-38). Claims 17, 26 and 27 also are amended for the sake of clarity to specifically recite the disrupted sample and the potassium-acetate solution containing said disrupted sample.

Claims 28 and 30 are rejected as allegedly obvious over Colpan *et al.* in view of Woodard *et al.* As stated in the Office Action, the rejection is based on the conclusion that it would have been obvious to a skilled person to use the kit of Colpan *et al.*, which is cited as containing lysis buffer (sodium hydroxide and 1% SDS), 3M potassium acetate solution and silica materials, while substituting the hydroxylated silicon dioxide-based silica polymers of Woodard *et al.*.

Applicants are amending claim 28 herein to advance prosecution in this case. The amendments incorporate subject matter from claim 29, which has not been rejected. Applicants submit that this amendment overcomes the rejection. The Office, by not rejecting claim 29, has conceded that this subject matter is allowable over these references, therefore, claim 28, which now recites "an alcohol solution containing 0.5% to 10% (w/v) SDS in 100% strength isopropanol" is allowable. Applicants request withdrawal of the rejection based on obviousness over Colpan *et al.* and Woodard *et al.*

Moreover, the "hydroxylated silica polymer" of Woodard *et al.* is produced by reacting silicon dioxide with alkali, followed by acidification. This composition is stated to have the advantage of not requiring binding reagents such as alcohols, which claimed methods. The present specification describes silicon dioxide support material prepared by adding acid to an aqueous suspension

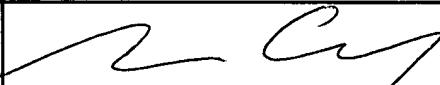
Serial No. 09/890,202
Filed: November 5, 2001
Page 9

of silicon dioxide (specification at page 3, lines 17-19). Thus it is clear that the combination of the two cited references could not result in the invention which is described here.

Claims 28 and 30 are rejected as allegedly obvious over Colpan et al. in view of Hillebrand et al. This rejection is based on the Office's conclusion that the skilled person would have found it obvious to use the kit of Colpan et al. substituting the silicon dioxide particles (grain size 7-300 mm, surface area 10-300 m²/g described by Hillebrand et al. Applicants submit that the amendments to claim 28, discussed above, overcome this rejection for the same reason. Applicants therefore request that the Office withdraw the rejection of these claims as obvious over the combination of Colpan et al. and Hillebrand et al.

The Office has indicated that claim 29 would be allowable if rewritten in independent form. Applicants have made this amendment to facilitate the prosecution of this claim, but maintain that claim 28, upon which claim 29 is dependent, is allowable.

Applicants now request allowance of the pending claims. If any issues remain outstanding, the Examiner is invited to telephone the undersigned.

RESPECTFULLY SUBMITTED,					
Name and Reg. No.	Martha Cassidy Reg. No. 44,066				
Signature			Date	3/1/04	
Address	Rothwell, Figg, Ernst & Manbeck Suite 800, 1425 K Street, N.W.				
City	Washington	State	D.C.	Zip Code	20005
Country	U.S.A.	Telephone	202-783-6040	Fax	202-783-6031